

(Corresponds exactly to Applicants' claim 63)

Comments: Proposed Count 1 alternatively comprises Yanagawa independent claim 1 and Applicants' independent claim 63.

Proposed designation of corresponding claims:

Yanagawa: Claims 1-23.

Applicants: Claims 47-76.

REMARKS

Applicants have proposed one count for interference, which recites, in the alternative, each party's independent claims for their inventive molecules (Yanagawa claim 1 and Applicants' claim 63). Applicants believe that their claimed methods of making their inventive molecule (claims 65-67), their methods of simulating protein evolution using the inventive molecule (claims 68-72), and their methods of assaying a protein/protein interaction or protein/nucleic acid interaction using their inventive molecules (claims 73-76) define separately patentable subject matter vis-à-vis the subject matter of claim 63, but for the purpose of administrative convenience and in accordance with the above-noted Restriction Requirement, have proposed only one count with all Yanagawa claims (except claim 24) and all of Applicants' claims corresponding thereto.

Brief Discussion Of The Involved Claims

Applicants' prior amendment added new claims 47-76. Of those new claims, claims 47-62 correspond substantially verbatim to certain claims of Yanagawa '943, as shown below.

Applicants' Claim	Yanagawa '943 Claim
47	1
48	2
49	3
50	4
51	5
52	6
53	10
54	11
55	12
56	15
57	16
58	19
59	20
60	21

61	22
62	23

Applicants have not presented any claim that recites subject matter corresponding to Yanagawa independent apparatus claim 24.

Applicants' claims 63-76 do not correspond verbatim to any of the Yanagawa claims, but rather correspond only partially to certain of the Yanagawa claims. Most notably, whereas all of Yanagawa's claims 1-23 recite the phrase "wherein said nucleic acid portion comprises a polymer of nucleoside,"¹ none of Applicants' claims 63-76 recite such a phrase. Rather, Applicants' claims 63-76 recite the phrase "wherein said nucleic acid portion comprises nucleotides," which is supported throughout Applicants' specification.

Applicants' Claims Are Not Barred Under 35 U.S.C. § 135(b)

The Yanagawa patent issued on March 26, 2002. Applicants' claims 47-76 were added by amendment dated September 27, 2002. Because Applicants' claims were added less than one year after issuance of Yanagawa, Applicants' claims 47-76 are not barred under 35 U.S.C. § 135(b).

¹ Yanagawa claim 1 recites the phrase "wherein said nucleic acid portion comprises a polymer of nucleoside." Claims 2-23 depend from claim 1 and thus include that limitation.

Applicants' Claim 63 Corresponding Exactly To The Proposed Count Is Entitled To The Benefit Of Its Provisional Application Of January 21, 1997

Applicants' claim 63, which corresponds exactly to Applicants' portion of the Proposed Count, is fully supported, in terms of 35 U.S.C. § 112, ¶ 1, by its earliest priority application, namely U.S. Serial No. 60/035,963, filed January 21, 1997 (the "'963 provisional"). A copy of the '963 provisional application is attached hereto as Appendix 1. Support for Applicants' claim 63, which corresponds exactly to Applicants' portion of the Proposed Count is found in the '963 provisional *inter alia* at page 2, lines 12-21, page 5, lines 11-12, page 16, lines 1-20, and Figure 1. Applicants' claim corresponding to the Proposed Count is thus entitled to the benefit of the '963 provisional application and its filing date of January 21, 1997, and, hence, Applicants should be accorded the benefit of their '963 provisional application for the Proposed Count.

Yanagawa's Claims Corresponding to the Proposed Count Are Not Entitled To The Benefit Of Yanagawa's Japanese Priority Application Because JP '855 Provides No Support Under § 112, ¶ 1 For The Phrase "Polymer of Nucleoside" Which Appears In Each Of Yanagawa Claims 1-23, As Well As The Yanagawa Portions Of Proposed Count 1

Yanagawa '943 issued from a U.S. National Phase application corresponding to a PCT Application filed in Japan on October 17, 1997. The Yanagawa PCT application claims priority to Japanese priority application No. 8-274855, filed October 17, 1996 (JP '855"). During prosecution of the '943 patent, Yanagawa filed a certified translation of JP '855 in the U.S. Patent Office. A copy of that certified translation is attached hereto as Appendix 2. A close examination reveals that the phrase "polymer of nucleoside" appears nowhere in JP '855. Indeed, the only discussions of "nucleosides" appear on pages 17 and 19 of the English translation of JP '855, and only in the context of a single nucleoside.²

² See page 17, lines 8-10 and 18-22, and page 19, beginning fourth line from the bottom.

Moreover, the phrase “polymer of nucleoside” also does not occur in the Yanagawa PCT as originally filed. The first occurrence of the term appears to be in the revised Abstract of the Disclosure filed with Yanagawa’s November 24, 2000 Amendment (copy attached as Appendix 3).³ It was also in that Amendment that Yanagawa added the phrase “polymer of nucleoside” to their claims (see Appendix 4 at page 2).

Whether intentionally or through error, Yanagawa introduced a limitation into its claims (“polymer of nucleoside”) that lacks either explicit or implicit support. That is, there is no disclosure that would lead one to believe that Yanagawa was in possession of any invention involving a polymer of nucleosides. For example, the disclosure in the last paragraph of page 19 of the English translation of JP ‘855 refers to the bonding between the nucleic acid portion and the protein portion of the molecule. Puromycin is one of several examples given. In the last few lines of page 19, Yanagawa suggests that a nucleoside or a nucleoside bound to an amino acid via an ester bond may also be used. Clearly, that passage does not suggest a “polymer” of nucleoside.

³ The original Abstract, which was page 85 of the PCT application, does not contain the phrase “polymer of nucleoside.” A copy of the original Abstract is attached as Appendix 5.

The only other disclosure relating to nucleosides is found on page 17 of the English translation of JP '855. That disclosure, however, does not pertain to the use of nucleosides but rather to the use of a substance "analogous to a nucleoside." Specifically, step (d) described on page 17 at lines 8-10 speaks of "bonding . . . a nucleic acid or a substance having a chemical structure analogous to that of a nucleoside and a base" In lines 18-22, it is stated that the "substance having a chemical structure analogous to that of a nucleoside and the base" is puromycin. There simply is no discussion or suggestion of a polymer of nucleoside.

Accordingly, Yanagawa's claims that correspond to the Proposed Count are not entitled to benefit of their JP '855 filing date of October 17, 1996.

Applicants Should Be Accorded Senior Party Status

For the reasons set forth above, Applicants have the earliest effective filing date for the Proposed Count. Therefore, Applicants are entitled to Senior Party status upon declaration of the interference. 37 C.F.R. § 1.601(m).

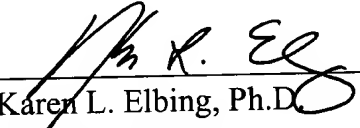
Conclusion

Enclosed is a Petition to extend the period for replying to the Office action for four months, to and including May 11, 2003, and a check in payment of the required extension fee.

If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 30 April 2003



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U.S. Serial No. 09/876,235
Version of Claims Showing Changes Made

In the claims:

Amend claim 65 as follows:

65. (Amended) A method for constructing the molecule as defined in claim 63, said method comprising (a) preparing a DNA containing a protein coding sequence; (b) transcribing the DNA into RNA; (c) covalently bonding to the 3' end of the protein coding sequence of the transcribed RNA a chemical structure selected from the group consisting of puromycin, a puromycin analog, and 3'-N-aminoacyladenosine aminonucleoside; and (d) translating the RNA in a cell-free protein synthesis system, thereby constructing the molecule of claim 63.

REQUEST FOR INTERFERENCE UNDER 37 C.F.R. § 1.607

Following Applicants' prior Amendment dated September 27, 2002, which added claims 47-76, Applicants hereby request an interference with U.S. Patent No. 6,361,943 to Yanagawa et al. ("Yanagawa"). Applicants propose that the interference be declared with the following count.

Proposed Count 1

A molecule comprising a nucleic acid portion and a protein portion covalently bound to said nucleic acid portion through a substance having a chemical structure of a member selected from the group consisting of puromycin, 3'-N-aminoacylpuromycin aminonucleoside, and 3'-N-aminoacyladenosine aminonucleoside, wherein said nucleic acid portion comprises a polymer of nucleoside, and said protein portion is encoded by said nucleic acid portion.

(Corresponds exactly to Yanagawa claim 1)

or

A molecule comprising a nucleic acid portion and a protein portion covalently bound to said nucleic acid portion through a substance having a chemical structure of a member selected from the group consisting of puromycin, an analog of puromycin, and 3'-N-aminoacyladenosine aminonucleoside, wherein said nucleic acid portion comprises nucleotides, and said protein portion is encoded by said nucleic acid portion.